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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,960	07/03/2003	Gordon P. Kurtenbach	1500.1005CDC	3561
21171 7590 03/20/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
TRAN, MYLINH T				
ART UNIT		PAPER NUMBER		
2179				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/611,960

**Applicant(s)**

KURTENBACH, GORDON P.

**Examiner**

MYLINH TRAN

**Art Unit**

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,7 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,7 and 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 02/25/08 has been entered.

Claims 24-25 have been added. However, the limitations of the new and current claims have not been found to be patentable over prior art of record; therefore, claims 1-3, 7 and 12-25 are rejected under the same ground of rejection as set forth in the Office Action mailed 08/23/07.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-22 are directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are at best, functional descriptive material per se.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7 and 12-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith [US. 5,721,853].

**As to claims 1, 7, 12, 15-16 and 23**, Smith teaches a computer implemented method and corresponding apparatus for a menu selection comprising the steps/means for a display displaying menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion (figure 3D, the radial marking menu portion on three quadrants: Tools, Ask AST and S/W Suites. These menu portions also are linear menu portions); a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location (figure 2, column 4, line 45 through column 5, line 3); and a computer connected to a display and said pointing device (figure 2, (23)), and determining selection criteria for the type

and a menu selection based on a method of selection from one of the stroke and the location (figure 3E, column 5, line 40 through column 6, line 6).

Smith also teaches a display displaying a menu comprising a radial marking menu portion and a linear menu portion at figure 3D.

Smith also teaches two different portions of radial marking menu (figure 3D) and linear menu (figure 3C).

**As to claim 2**, Smith teaches the menu including at least nine selectable menu items (figure 3E).

**As to claim 3**, Smith teaches the menu including at least one menu item selectable based on the designating of only a location (figure 2, column 4, line 45 through column 5, line 3).

**As to claims 13-14, 17**, Smith teaches specifying selection criteria of a radial marking menu item when a method of selection is a stroke direction in the radial marking menu portion (column 5, lines 40 through column 6, line 6) and specifying selection criteria of a linear location menu item when a method of selection uses an end point of the stroke when the stroke is in a linear location selection region (column 5, lines 4-40).

Smith teaches the radial marking menu portion at figure 3D and the linear menu portion at figure 3C.

**As to claims 18-19**, Smith shows making a stroke in a menu, selecting a displayed first item of the menu when the stroke terminates inside the displayed first item of the menu and selecting, based on the stroke, a second item of the

menu, when the stroke does not terminate inside any displayed items of the menu (figure 3D, column 6, lines 27-55).

**As to claims 20-22**, Smith teaches a radial portion, a linear portion and a menu selection being based on a stroke, selection of a radial menu item of radial portion being suppressed when a pointer location is in the linear portion (column 5, lines 4-40), the radial menu item selection being reactivated when the pointer location exits a linear item in the linear portion and when the pointer location crosses a radial portion boundary line extending across the menu (column 5, line 40 through column 6, line 6).

**AS to claim 24**, Smith teaches the pointing device allowing a user to select by both making a stroke and designating a location and for indicating a type of selection by the user making one of a stroke having a direction for radial marking menu selection and designating a location (selection of each of the quadrants 202-208 (figure 3A-E) is by movement of the mouse pointer (23) into any of the four quadrants causes the corresponding secondary interface to be displayed. Moving the mouse pointer (23) over the quadrant 204 (figure 2) labeled "Ask AST" a cause a secondary interface comprising plurality of menus. These menus are displayed and selected by movement of the mouse pointer into any of the four quadrants (a stroke). The step of moving the mouse pointer over these quadrants is similar to the step of making a stroke having a direction and designating a location).

**As to claim 25**, Smith teaches the pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location local to both the display and the pointing device (selection of each of the quadrants 202-208 (figure 3A-E) being by movement of the mouse pointer (23) into any of the four quadrants causes the corresponding secondary interface to be displayed is considered as a radial marking selection type. Selection of any menu from a linear menu portion 306d, figure 3D is considered as a linear selection type. Therefore, it is clear that Smith teaches determining selection criteria for the type and a menu item selection based on a method of selection from the one of the stroke and the location).

#### ***Response to Arguments***

Applicant has argued about the Declarations and Attachments filed 06/11/07. The arguments have been considered but they are still not persuasive. Therefore, the rejection has been maintained.

1) Both Declarations and Attachments filed 06/11/07 under 37 CFR 1.131 have been considered but they are ineffective to overcome the applied references.

a) Appellant seeks to establish prior invention by showing reduction to practice before April 28, 1995, the date of the Smith reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Smith reference. While conception is the mental

part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In Declaration under 37 C.F.R. 1.131 filed 09/30/2004, second paragraph, claimed "to put together a variety of mock-up data and programs in the same computer to demonstrate the base premise of the concept"; however, this concept was only implemented on a single (or local) computer and the Applicant did not know how to make the concept working as claimed "a pointing device for indicating a type of selection by one of making a stroke having a direction and designating a location". Therefore, it raises the question whether or not the applicant has a conception before the reference date.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the reference, see MPEP 715. The Attachments A-E comprise a menu template of draft code as well as sample display format for the display of all menu portions and related items. They are, individually or together, still not evidence that provide a showing of facts in character and weight. Therefore, the evidence is still insufficient to establish a "reduction to practice" of the invention in this country or a NAFTA or WTO member country prior to the effective date of the reference.



**b)** In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. (*See MPEP 715.07*)

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). (*See MPEP 2138.05*).

The evidence submitted is also insufficient to establish diligence from a date prior to the date of reduction to practice of the Smith reference to either a constructive reduction to practice or an actual reduction to practice. The affidavit fails to establish an alleged reduction to practice prior to the application filing date. There is no evidence provided by the Applicant in the critical period which is the time between the time just prior to the filing date of the Smith reference to the filing date of this application. MPEP 2138.06 states that "the critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice", and "an Applicant must account for the entire period during which diligence is required".

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence needs not to be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958)

However, in the interest of compact prosecution, the examiner notes that the evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Smith reference (04/28/1995) to the US filing date of this application (06/06/95) because of periods of lacking activity in the Attachments without any explanation such as periods of 2 months between April 28, 1995 and June 06, 1995

c) There is not enough evidence to clearly prove the relationships between Declaration, Attachments and the claims. Therefore, no reduction to practice has been shown and Applicant has failed to establish prior invention. The declaration and accompanying Attachments do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore do not support conception of the claimed invention. For example, there is not explanation of the exhibits or positive statement on the declaration to support the limitation "a display displaying a menu comprising a radial marking menu portion simultaneously displayed with a linear menu portion, a pointing device for indicating a type of selection by one of making a stroke

having a direction and designating a location; and a computer connected to said display and said pointing device, and determining selection criteria for the type and a menu item selection based on a method of selection from the one of the stroke and the location" in claims 1 and 7-19. The aforementioned limitations in claims 1, 7-19 merely provide as example of insufficient evidence supporting conception of the claimed invention. It is to be understood that there are other claimed limitations that are not sufficiently supported by the evidence provided by the declaration and the accompany Attachments.

2) Applicant has argued that Smith fails to provide "specific factual findings predicated on sound technical and scientific reasoning". However, Smith also teaches two different portions of radial marking menu (figure 3D) and linear menu (figure 3C).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran. The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached at 571-272-4847.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/M. T./

Examiner, Art Unit 2179

/Weilun Lo/

Supervisory Patent Examiner, Art Unit 2179